HILLE INTERNATIONAL LTD.

v.

TIONG HIN ENGINEERING PTE. LTD.

HIGH COURT, SINGAPORE
AP RAJAH J
[SUIT NO. 595 OF 1979]
22 OCTOBER 1982

CIVIL LAW ACT: *Registered trade mark - Infringement - Passing off.*

The plaintiffs, a company registered in the United Kingdom, claimed against the defendants for (1) infringement of their registered trade mark "hille" and (2) passing off the defendants' polypropylene chair shells as and for those of the plaintiffs. (The defendants did not dispute that the plaintiffs were the registered proprietors of the said trade mark, or that it had been registered as claimed or that it had at all material times been valid and subsisting. They only disputed the plaintiffs' claim that their mark "CILLY" represented the plaintiffs' mark "hille" as to be likely to deceive or cause confusion in the trade).

Held:

[1] The defendants deliberately invented the word "CILLY" to deceive and cause confusion in the trade, which word sounded so like the word "hille" that there was a serious possibility of deception. *(White Hudson v. Asian Organisation* [1965] 31 MLJ 186; *Fialho v. S.D. Simond & Co. Ltd.* [1937] 54 RPC 193)

[2] There was no passing off the defendants' goods as those of the plaintiffs. The colours and shapes used by the defendants for their shells were common to the trade.

[Injunction with regard to the mark "CILLY" granted.]

Cases referred to:
White Hudson v. Asian Organization [1965] 31 MLJ 186
Fialho v. S.D. Simond & Co. Ltd. [1937] 54 RPC 193

JUDGMENT

AP Rajah J:

The plaintiffs' claim against the defendants is for (1) infringement of their Registered Trade Mark "hille" (pronounced as in "hilly") No. 50243 (the said Trade Mark) and (2) passing off the defendants' polypropylene chair shells as and for those of the plaintiffs.

The plaintiffs are a company incorporated in the United Kingdom and have their registered office at 132 St. Albans Road, Watford, Hertfordshire WD 2 4 AG, United Kingdom. The said Trade Mark was registered in Class 20, in respect of furniture and parts and fittings therefor, on 7 October 1970, and such registration is and has, at all material times, been valid and subsisting.

Since 1968 the plaintiffs have used the said Trade Mark extensively upon their polypropylene chair shells and their polypropylene chair shells so marked have come to be well known in the trade and to the public as those of the plaintiffs.

The defendants were incorporated in 1974 as a private limited company. They acquired and took over as a going concern the firm of Tiong Hin Engineering Works and continued to carry on the business of the said firm mainly manufacturing steel office furniture and

household furniture. The defendants are the registered proprietors of the Trade Mark **"Sunflag"** and **"DAGLO"** which were registered in 1974 and 1977 respectively in Class 20, in respect of all types of furniture.

In 1975 the defendants became aware for the first time that the plaintiffs were selling polypropylene shells under the mark "hille" (See Interrogatory 8 and Answer thereto). In 1976 or thereabouts they decided to manufacture polypropylene shells but before this could be done a mould in the requisite shape had to be made. The chairman of the defendant company (DW1) happened to be in Taiwan in March 1977. There he saw, so his evidence goes, many such shells - the "hille" shell was not amongst those he saw. He examined these shells and bought one of them which, in his view, suited his requirements for manufacture in Singapore. At the same time he, although he knew no English, invented a trade mark in the English language, to wit, "CILLY" (pronounced as in "silly"). He then ordered in Taiwan a mould to be made of the shell he had bought and with the word "CILLY" incorporated into the mould. His "CILLY" polypropylene shell manufactured from the said mould came on to the market in or about July 1977.

The plaintiffs say that, since the registration of their said Trade Mark and prior to the issue of the writ in this action on 27 February, 1979, the defendants had infringed the plaintiffs' said Trade Mark "hille" by their using, in the course of trade in Singapore in relation to their polypropylene chair shells, the trade mark "CILLY" which look and sound so alike the said Trade Mark that it could lead to confusion or deception or a possibility of such confusion or deception.

The plaintiffs further say that such use of the mark "CILLY" by the defendants not only infringes their said Trade Mark but is also calculated to lead to deception and to the belief that the defendants' polypropylene chair shells are the polypropylene chair shells of the plaintiffs and is further calculated to cause and must have caused polypropylene chair shells not of the plaintiffs' manufacture or merchandise to be passed off as and for the polypropylene chair shells of the plaintiffs and that the plaintiffs have thereby suffered damages and will suffer damage.

The defendants in their defence deny any infringement as claimed by the plaintiffs and say that:

(a) that they have not infringed the plaintiffs' Trade Mark;

(b) that the said Trade Mark "hille" and the mark "CILLY" are visually and phonetically different;

(c) that they have not passed off their polypropylene chair shells as those of the plaintiffs' and that there is no confusion or deception or a possibility of confusion or deception arising from the defendants' use of the trade mark "CILLY", as the differences in the respective trade marks are sufficient to obviate any possibility of confusion or deception;

(d) that their customers were not deceived or confused as a result of their use of the trade mark "CILLY".

Infringement of plaintiffs' Registered Trade Mark ***"hille"***

To succeed in their claim that their said Trade Mark has been infringed by the defendants, the plaintiffs must prove that:

(1) they are the registered proprietors of the said Trade Mark;

(2) the said Trade Mark has been registered in Class 20 in respect of furniture and parts and fittings therefor;

(3) the said Trade Mark is and has at all material times been valid and subsisting;

(4) the defendants have, since the registration of the said Trade Mark, and before the issue of the writ in this action, infringed the said Trade Mark by using in the course of trade in Singapore in relation to their polypropylene chair shells, the mark "CILLY" which so nearly resembles the said Trade Mark as to be likely to deceive or cause confusion in the course of trade.

The defendants by their defence do not dispute ingredients (1), (2) and (3) set out above. As to ingredient (4), they dispute it only to the extent that their mark "CILLY" does not so nearly resemble the said Trade Mark as to be likely to deceive or cause confusion in the trade.

The crucial question for decision is whether the mark "CILLY" so nearly resembles the plaintiffs' trade mark as to be likely to deceive or cause confusion in the trade. In this connection it is relevant to note that in the defendants' solicitors' reply dated 5 October 1978 in response to the plaintiffs' letter of complaint dated 11 September 1978 the following passage appears, "Our clients state that phonetically and visually their trade mark is completely different: it should be noted in this regard that our clients' mark 'CILLY' is pronounced 'silly' while your clients' mark 'hille' is pronounced 'hill'." An attempt was made during the trial by the defendants to maintain this position. However, towards the close of the defendants' case it was conceded by the Managing Director of the defendant company, (DW2), that they knew that the said Trade Mark "hille" was known in the market as in "hilly" and not as in "hill". So the question to be answered is whether the trade mark "hille" pronounced as in "hilly" and the trade mark "CILLY" pronounced as in "silly" so nearly resemble each other in sound as to be likely to deceive, or cause confusion in the trade. In this connection, one must keep in mind that not all customers in Singapore speak or write English. This is an even more important factor in deciding such a question [see *White Hudson v. Asian Organization* [1965] 31 MLJ 186] than it would have been had all customers in Singapore been English speaking. The chairman of the defendant company in his evidence gave a fanciful explanation of how he came to hit upon the word "CILLY" for his trade mark. I have no doubt that this fanciful explanation was invented by him for purposes of this trial. His *bona fides* is suspect for if he had just wanted a trade mark for his polypropylene shells he already had a registered trade mark, namely, "Sunflag" in March 1976, which he could have made use for his polypropylene shells. His *bona fides* is even more suspect when it is now known that after the issue of the Writ the defendants had been using the Mark "DAGLO" on the selfsame shells that had previously carried the mark "CILLY". I am satisfied that on the evidence before me that the defendants deliberately invented the word "CILLY" to deceive and cause confusion in the trade. The ultimate sound of the two words "hille" and "CILLY" when pronounced in speech are so similar that it is bound to deceive and cause confusion. The case nearest to the instant case which I have been able to find is that of the Court of Appeal case of *Fialho v. S.D. Simond & Co. Ltd.* [1937] 54 RPC 193. In this case "the plaintiffs, a Portuguese firm, who had carried on business by themselves and their predecessors since 1892, were importers (*inter alia*) of tinned sardines into the United Kingdom. They were the registered proprietors of Trade Mark No. 204985 registered in Class 42, consisting of the words 'Marie Elizabeth' and a pictorial design, and of Trade Mark No. 424307 also registered in Class 42 consisting of words 'Marie Elizabeth' alone. The defendants sold a consignment of tinned sardines obtained from America and bearing the words 'Maria Lisette', the whole of which had been sold prior to the action, and had also issued a circular offering 'Marie Lisette' tins of sardines. Held, that the Mark 'Marie Elizabeth' and its abbreviation 'Maries' indicated the plaintiffs' goods, and that the use of the mark 'Maria Lisette' or Marie Lisette' was an infringement of the Trade Marks and was calculated to pass off; and that,

although the defendants no longer had any goods marked in this way in their possession, the plaintiffs were nevertheless entitled to an injunction. The usual other relief was granted." Towards the closing stage of his judgment Farwell J had this to say:

> So far as the Trade Mark is concerned, the names are so closely connected and so much alike that it is extremely difficult to avoid the conclusion that there was some intention, on the part of those who selected them, to get the benefit, so far as it was possible, of the plaintiffs' goodwill. In my judgment there is in this case such a taking of the name of the plaintiffs as to lead to serious possibility of deception, and to amount to an infringement of both the Trade Marks.
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> (Page 198 lines 47 to 53).

With regard to the passing off of the defendants' goods as those of the plaintiffs, the plaintiffs were suggesting that the shape and colour of the defendants' polypropylene shells were about the same or so close one to the other that the defendants by a combination of shape, colour and the use of the word "CILLY" were passing off or attempting to pass off their goods as those of the plaintiffs. I am, however, of the view that the colours and shapes used in the manufacture of polypropylene shells are common to the trade. I am sustained in this view by the fact that the plaintiffs are not pursuing by action the marketing by the defendants of the self-same polypropylene shells under their registered trade mark "DAGLO".

There will be an injunction with regard to the mark "CILLY" as asked for in para. 1 of the prayers of the statement of claim and an order in terms of prayers 3 and 4 thereof.

Also found at [1983] 1 CLJ 50